

A<sup>1</sup>

(e) at least one oxidizing agent,  
wherein said at least one oxidizing agent is present in an amount ranging from  
0.1% to 20.0% by weight relative to the total weight of the composition.

A<sup>2</sup>

141. (Amended) The method according to claim 139, wherein R is chosen from  
linear C<sub>8</sub> to C<sub>22</sub> alkenyl groups, branched C<sub>8</sub> to C<sub>22</sub> alkenyl groups, and cyclic C<sub>8</sub> to C<sub>22</sub>  
alkenyl groups.

A<sup>3</sup>

162. (Amended) The method according to claim 110, further comprising:  
(e) at least one oxidizing agent,  
wherein said at least one oxidizing agent is chosen from hydrogen peroxides,  
bromate salts, percarbonate salts, perborate salts and enzymes.

163. (Amended) The method according to claim 110, further comprising:  
(e) at least one oxidizing agent,  
wherein said at least one oxidizing agent is present in an amount ranging from  
0.1% to 20.0% by weight relative to the total weight of the composition.

**REMARKS**

**I. Status of the Claims**

Claims 1-168 are pending in this application. Claims 107, 108, 141, 162, and  
163 have been amended.

Claims 107, 108, 162, and 163 have been amended to provide antecedent basis  
for "at least one oxidizing agent". Applicants believe these amendments in no way  
narrow the scope of these claims.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

**II. Claim Objection**

Claim 141 is objected to for reciting a "composition," and not a method. Office Action at p. 2. Applicant wishes to thank the Examiner for noting this typographical error. Accordingly, claim 141 has been amended to replace "composition" with method. Because this amendment was made to correct a typographical error, it is believed that this amendment in no way narrows the scope of claim 141.

**III. Rejections under 35 U.S.C. § 112, second paragraph**

Claims 3-4, 9-12, 26, 29, 33-36, 58-59, 64-67, 81-86, 88-92, 113-114, 119-125, 136, 139, 140-141, 143, and 145-147 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Office Action at p. 2. Applicant respectfully traverses this rejection.

The Examiner alleges that the limitation "groups are optionally substituted" is unclear because it is "unclear what types of substituents are presented in the hydrocarbon chains." *Id.*

Applicant respectfully disagrees. The standard of definiteness under 35 U.S.C. § 112, second paragraph, is a reasonable degree of clarity and precision. M.P.E.P. § 2173.02. "Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made."

*Id.* The use of "optionally" does not automatically render a claim indefinite *per se*. "[A] claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought." M.P.E.P. § 2173.01; see also *In re Swinehart*, 439 F.2d 210 (C.C.P.A. 1971). One of ordinary skill in the art would know which groups can be substituted. Moreover, the specification provides numerous examples of such substituted groups. See, e.g., specification at p. 4, line 9 to p. 5, line 12. Specific examples of substituted and unsubstituted alkyl, alkylene, alkenyl, and alkylenylene groups are also listed throughout the specification. In light of the guidance provided by the specification and the knowledge of one of ordinary skill in the art, the optional recitations are clear and thus, the meaning of the rejected claims is sufficiently definite.

Accordingly, Applicant respectfully requests withdrawal of this rejection.

#### IV. Rejection under 35 U.S.C. § 103

Claims 1-168 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,009,880 (Grollier et al.). Office Action at pp. 3-5. Applicant respectfully traverses this rejection.

The Examiner states that Grollier teaches a composition comprising a cationic homopolymer such as Quaternium 37, fatty alcohols, polyoxyethyleneated or polyglycerolated fatty alcohols, polyoxyethyleneated fatty amides and mono- or diethanolamides, and oxidizing agents. Office Action at pp. 3-4.

In making a rejection under 35 U.S.C. § 103, the Examiner has the initial burden to establish a *prima facie* case of obviousness. M.P.E.P. § 2143. To meet this burden,

there must be some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to modify reference teachings with a reasonable expectation of success in obtaining the presently claimed invention.

M.P.E.P. § 2143.01; 2143.02.

Applicant respectfully disagrees that Grollier teaches the claimed invention.

Grollier is directed to a composition comprising a combination of a cationic polymer with an anionic polymer. See Abstract. Although the Examiner points to the allegedly claimed ingredients in isolated passages in Grollier, Grollier provides no specific guidance for a single composition or oxidizing composition comprising the Applicants' claimed ingredients, i.e.:

- (i) the at least one cationic homopolymer, as claimed;
- (ii) at least one fatty alcohol;
- (iii) at least one alkoxyated fatty alcohol;
- (iv) at least one fatty amide; and
- (v) at least one oxidizing agent (claims 1-56, 107-109, and 162-164).

First, Grollier discloses a very large number of potential cationic polymers within col. 4, line 20 to col. 35, line 64. Grollier does not specifically single out the claimed cationic polymer. Quaternium 37 is mentioned only once in the specification and is not used in any of the exemplary formulations. Thus, one of ordinary skill in the art would not be motivated to use the claimed cationic homopolymer without further specific guidance from Grollier.

Second, the Examiner points to certain passages in col. 51 of Grollier to show that Grollier teaches fatty alcohols and alkoxylated fatty alcohols. Office Action at pp. 3-4. The fatty alcohol is only one of many possible solubilising agents taught by Grollier. Grollier further teaches that it is necessary only *in certain cases*, to add a solubilising agent, such as surface-active agents or cosmetically acceptable solvents. Moreover, each of the surface-active agents or cosmetically acceptable solvents encompass present a myriad of possible compounds. Col. 46, lines 41-45. Grollier discloses "treatment creams or milks to be applied before or after colouring or bleaching, before or after shampooing or before or after permanent waving." These creams or milks can comprise "fatty alcohols, in the presence of emulsifiers." Col. 51, lines 18-25. To arrive at the combination of fatty alcohols and alkoxylated fatty alcohols (claimed components (ii) and (iii)), one would have to choose the particular emulsifier, which can be anionic or non-ionic surface-active agents. Col. 51, lines 44-47. Thus, Grollier fails to guide one of ordinary skill in the art to combine the claimed cationic homopolymer with at least one fatty alcohol and clearly does not motivate one of skill in the art to combine fatty alcohols and alkoxylated fatty alcohols with the claimed cationic homopolymer, much less the claimed combination of ingredients (i)-(v).

Third, the Examiner points to passages in col. 52 of Grollier to show that Grollier teaches oxidizing agents. Office Action at p. 4. Grollier, however, does not provide motivation to combine oxidizing agents with the claimed combination of ingredients (i) to (iv). In fact, according to Grollier, oxidizing agents are used in "colouring creams," which are distinct from the treatment creams or milks. Col. 52, lines 10-16 and 34-37.

Colouring creams contain colourants, such as oxidation dyestuffs, which are converted into dyestuffs by a condensation reaction in the presence of the oxidizing agent.

Clearly coloring creams are not "applied before or after colouring or bleaching, before or after shampooing or before or after permanent waving" like Grollier's treatment creams or milks. Thus, Grollier teaches away from combining oxidizing agents with the fatty alcohol or alkoxylated fatty alcohols of the treatment creams, much less the claimed combination of ingredients (i) to (iv).

Finally, the Examiner refers to col. 49 of Grollier to show that Grollier teaches fatty amides. Office Action at p. 4. This is an isolated passage unrelated to the treatment creams or colouring creams discussed above. Fatty amides are listed as a possible non-ionic surface active agent. See col. 48, lines 30-35 and col. 49, lines 5-6. There is no teaching in Grollier to combine fatty amides with the claimed combination of ingredients (i) - (iii), and (v).

A *prima facie* case of obviousness made against these claims requires evidence of a specific suggestion from the art, as such evidence must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). See also *In re Lee*, 377 F.3d 1338, 1343 (Fed. Cir. 2002). ("The need for specificity pervades this authority."). Such specificity is not shown here. Instead, the Examiner's rejection amounts to picking and choosing from a myriad of possible ingredients. Only by using the Applicant's claims as a blueprint can one of ordinary skill of the art arrive at the claimed invention, which is an improper basis for a *prima facie* case of obviousness. *Sensonics v. Aerosonic*, 81 F.3d 1566, 1570 (Fed. Cir. 1996). ("To draw on hindsight knowledge of the patented

invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction--an illogical and inappropriate process by which to determine patentability.”).

Accordingly, Applicant respectfully requests withdrawal of this rejection.

**V. Conclusion**

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Preliminary Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: March 5, 2003

By: Maia Bantet, Reg. No. 52,576  
for Anthony C. Tridico  
Reg. No. 44,455

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

**APPENDIX: MARKED UP COPY OF AMENDED CLAIMS**

107. (Amended) The method according to claim 57, **further comprising:**

**(e) at least one oxidizing agent,**

wherein said at least one oxidizing agent is chosen from hydrogen peroxides, bromate salts, percarbonate salts, perborate salts and enzymes.

108. (Amended) The method according to claim 57, **further comprising:**

**(e) at least one oxidizing agent,**

wherein said at least one oxidizing agent is present in an amount ranging from 0.1% to 20.0% by weight relative to the total weight of the composition.

141. (Amended) The [composition] **method** according to claim 139, wherein R is chosen from linear C<sub>8</sub> to C<sub>22</sub> alkenyl groups, branched C<sub>8</sub> to C<sub>22</sub> alkenyl groups, and cyclic C<sub>8</sub> to C<sub>22</sub> alkenyl groups.

162. (Amended) The method according to claim 110, **further comprising:**

**(e) at least one oxidizing agent,**

wherein said at least one oxidizing agent is chosen from hydrogen peroxides, bromate salts, percarbonate salts, perborate salts and enzymes.

163. (Amended) The method according to claim 110, **further comprising:**

**(e) at least one oxidizing agent,**

wherein said at least one oxidizing agent is present in an amount ranging from 0.1% to 20.0% by weight relative to the total weight of the composition.